

### **REMARKS**

Applicants request reconsideration of this application in view of the present Amendment.

Claims 1-20 and 31 are cancelled. Claims 21-30 are pending. Claim 21 is amended to more clearly define the invention. No additional searching is believed to be required by the examiner based on the amendments to claim 21 because the amendments narrow the scope of the claim from that which was submitted initially, thus the scope of the amended claim should be within the scope of the original search.

#### **35 U.S.C. § 102(e)--Guan et al. (U.S. 6,149,882)**

Claim 27 recites an apparatus for transferring and releasing air-sensitive and/or moisture-sensitive and/or light-sensitive substances from a synthesis chamber to a separate test reactor.

The apparatus of claim 27 includes the following elements:

- a synthesis chamber for preparing an air-sensitive and/or moisture sensitive and/or light-sensitive substances *in closed vessels*;
- connection lines in fluid communication between the opening of the closed vessel and the test reactor; and
- means for transferring the substance in the closed vessel with an opening from the synthesis chamber to the test reactor comprising at least one multiport valve for determining which substance to transfer from a closed vessel with an opening to the test reactor.

Guan does not disclose any of these elements of claim 27.

Guan discloses an apparatus and method for rapid analysis of members of a combinatorial library. Guan does not, however, disclose a synthesis chamber capable of preparing substances *in closed vessels*. The Office Action implies that the fluid mixing unit of Guan (22) is a synthesis chamber. However, the fluid mixing unit of Guan (22) simply directs test fluids to flow through a manifold (58) into a feed line (60). Because Guan's fluid mixing chamber simply directs test fluid flow into a single feed line, the mixing chamber cannot be characterized as a synthesis chamber. Even if the fluid mixing chamber of Guan could be interpreted as a synthesis chamber, which the applicants do not acknowledge, that fluid mixing chamber/"synthesis chamber" is not capable of *containing* a closed vessel. Because Guan does not disclose a reaction chamber capable of containing closed vessels, Guan also does not disclose connection lines in fluid communication between the opening of a closed vessel and the test

reactor *or* means for transferring the substance in a closed vessel with an opening from the synthesis chamber to the test reactor comprising at least one multiport valve for determining which substance to transfer from a closed vessel with an opening to the test reactor.

Because Guan discloses neither a synthesis chamber for preparing an air-sensitive and/or moisture sensitive and/or light-sensitive substances in closed vessels; connection lines in fluid communication between the opening of the closed vessel and the test reactor; *nor* means for transferring the substance in the closed vessel with an opening from the synthesis chamber to the test reactor comprising at least one multiport valve for determining which substance to transfer from a closed vessel with an opening to the test reactor, claim 27 is not anticipated by Guan under 35 U.S.C. § 102(e). Dependent claim 28 contains features that further distinguish the claim from the disclosure of Guan and, thus, also is not anticipated by Guan under 35 U.S.C. § 102(e).

**35 U.S.C. § 103(a)--Lebl et al. (U.S. 6,045,755)**

Amended claim 21 recites an apparatus for transferring and releasing air-sensitive and/or moisture-sensitive and/or light-sensitive substances *in a vessel* from a synthesis chamber to a test reactor and includes the following:

- a synthesis chamber for preparing an air-sensitive and/or moisture-sensitive and/or light-sensitive substance *in a vessel* and enclosing the substance within *the vessel*,
- a test reactor,
- means for transferring the substance *in the vessel* from the synthesis chamber to a test reactor, and
- means for freeing, within the test reactor, the substance *in the vessel* from the means for protecting the substance, wherein said means are capable of destroying said means for protecting the substance.

In contrast, Lebl does not disclose a vessel in which the air-sensitive and/or moisture-sensitive and/or light-sensitive substance is enclosed, a test reactor, means for transferring a vessel in which an air-sensitive and/or moisture-sensitive and/or light-sensitive substance is enclosed, *nor* means for freeing an air-sensitive and/or moisture-sensitive and/or light-sensitive substance from within a enclosed vessel.

Lebl discloses an integrated robot apparatus for performing combinatorial chemistry synthesis protocols. In contrast to the apparatus described by amended claim 21, the Lebl apparatus does not include a test reactor. Rather, Lebl discloses reaction vessels that are not a separate test reactor. The Lebl device prepares its combinatorial products in reaction vessels that can be enclosed in sub-enclosures capable of retaining an inert atmosphere. These reaction vessels cannot, however, be enclosed, nor can these reaction vessels be transferred to a separate test reactor. Lebl specifically states:

"After the desired number of building block addition steps, the final compound is present in the reaction vessel attached to the solid-phase support. The final compounds can be utilized either directly attached to their synthetic supports, or alternatively, can be cleaved from their supports." Lebl, column 9, lines 32-37.

Thus, enclosing the air-sensitive and/or moisture-sensitive and/or light-sensitive substance in a vessel is not disclosed, nor is transferring the substance in the vessel to a separate test reactor. Further, Lebl does not disclose any ability within his apparatus for testing his final compound. Rather Lebl indicates that in order to test his compounds he must remove the compounds from his apparatus and separately analyze them with liquid chromatography and mass spectrometry instruments. *See* Lebl, column 41, lines 53-58. Thus, the completed synthesis of the final compounds is the limit of the capability of Lebl's apparatus and there is no disclosure of an enclosed vessel or the transfer of the enclosed vessel.

In addition to the fact that Lebl does not disclose a test reactor or an enclosed vessel that can be transferred, Lebl further does not disclose means for freeing, within the test reactor, the substance in the vessel from the means for protecting the substances, wherein said means are capable of destroying said means for protecting the substance. The Office Action indicates that Lebl discloses means for freeing within the test reactor at col. 13, lines 33-40. However, what is disclosed at col. 13, lines 33-40 is simply a syringe fluid manipulation tool for manipulating fluid transfer syringes. This syringe tool is not disclosed to be capable of destroying a means for protecting the substance, which in this case includes an enclosed vessel. Lebl's syringe tool is not a destructive apparatus and is not capable of destroying anything. Rather, at best Lebl's syringe tool can penetrate, *but not destroy*, a septum, and inject, *but not free from its protecting*

*means*, a liquid sample. Additionally, none of these syringe tool actions described by Lebl occur in a test reactor as required by amended claim 21.

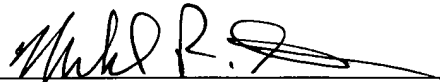
Because Lebl discloses neither a synthesis chamber for preparing an air-sensitive and/or moisture-sensitive and/or light-sensitive substance *in a vessel* and enclosing the substance within *the vessel*; a test reactor; means for transferring the substance *in the vessel* from the synthesis chamber to a test reactor; *nor* means for freeing, within the test reactor, the substance *in the vessel* from the means for protecting the substance, wherein said means are capable of destroying said means for protecting the substance, amended claim 21 is not obvious over Lebl under 35 U.S.C. § 103(a). Dependent claims 22-26 and 29 contain features that further distinguish those claims from the disclosure of Lebl and, thus, also are not obvious over Lebl under 35 U.S.C. § 103(a).

Claim 30 defines an apparatus including a synthesis chamber for preparing an air-sensitive and/or moisture-sensitive and/or light-sensitive substance and enclosing the substance within a sealable vessel for protecting the substance; a test reactor; a robot for transferring the substance from the synthesis chamber to the test reactor; and means for freeing, within the test reactor, the substance from the sealable vessel, wherein said means are capable of destroying said sealable vessel. As discussed above for amended claim 21, Lebl neither discloses a synthesis chamber for preparing an air-sensitive and/or moisture-sensitive and/or light-sensitive substance and enclosing the substance within a sealable vessel for protecting the substance; a test reactor; a robot for transferring the substance from the synthesis chamber to the test reactor; *nor* means for freeing, within the test reactor, the substance from the sealable vessel, wherein said means are capable of destroying said sealable vessel. Thus, claim 30 also is not obvious over Lebl under 35 U.S.C. § 103(a).

**Conclusion**

For the reasons discussed above, Applicants respectfully submit that the application is in condition for allowance and allowance is requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael R. Asam", written over a horizontal line.

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